



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,068	06/29/2001	O. James Peterson IV	3000.2	9470
29494 7590 12/28/2006 HAMMER & HANF, PC 3125 SPRINGBANK LANE SUITE G CHARLOTTE, NC 28226			EXAMINER HARBECK, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			3692	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/28/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/896,068	Applicant(s) PETERSON IV, O. JAMES	
	Examiner Timothy M. Harbeck	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Editors (Business Editors. "USCreative Joins WorkExchange – the Internet's Largest
Marketplace for Work; Project Marketplace Continues Skyrocketing Growth." Business
Wire. New York: Dec 13, 1999. pg 1) in view of McLoughlin (McLoughlin, Tom.
Government Finance Review. Chicago: Jun 1990 Vol 6, Iss. 3; pg. 28 3 pgs)

Re Claim 1: Editors discloses a method for an entity, the entity being a governmental or business entity, to procure a product from an institution comprising the steps of:

- Posting a request for proposal for the product of the entity to a website (Page 2, 10th paragraph "When an employer posts a project...").
- Electronically notifying the institution that the RFP has been posted (Page 2, 10th paragraph; "proprietary matching engine to select the best qualified freelancers and alert them to bid on the project.")
- Reviewing the RFP by the institution (Page 2, 10th paragraph; the step of bidding implies that the RFP has been reviewed)

- Electronically notifying the entity of a result of the review by the institution
(page 2, 10th paragraph “employer can choose one based on their skill.”)

Editors does not explicitly disclose wherein the product is a financial product and the institution is a financial institution. McLoughlin discloses that governments have, for some time, issued a request for proposal as a means of selecting an underwriter to finance bonds intended for public improvements (abstract). It would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of McLoughlin to the disclosure of Editors, as a means for a government entity to solicit a specific type of product or service from a specific type of vendor. While Editors does not explicitly disclose the products and/or services from which each government entity might solicit a vendor, McLoughlin details that a request for a financial product from a financial institution, via a RFP, is old and well known. Utilizing the Editors method of online dissemination of the financial product RFP would therefore reach a greater audience and potentially lead to a better contract for the government entity.

Re Claim 2: Editors in view of McLoughlin discloses the claimed method supra and McLoughlin further discloses

- Profiling the entity by obtaining information about the entity that may be utilized by the financial institution in making the financial institution’s decision to offer the financial product to the entity (See abstract; “The RFP should describe the purpose for which the bonds will be issued, the source or sources of revenues expected to be pledged to bond security, the anticipated size and term of the issue...”).

Art Unit: 3692

- Providing a deal sheet, the deal sheet outlining the entity's need for the financial product (See abstract; "The RFP should describe the purpose for which the bonds will be issued").

While the references do not explicitly disclose the step of authorizing the posting of the RFP by an official of the entity, this step is old and well known in the art and would have been obvious to anyone of ordinary skill to prevent the fraudulent and or mistaken posting of potential contracts to the system. In requiring an authorization step by an official the systems integrity can be maintained all parties can be assured a level of security in the process.

Re Claim 3: Editors in view of McLoughlin discloses the claimed method supra and Editors further discloses wherein posting the RFP to the website further comprises the step of:

- Identifying at least one financial institution that will have access to the RFP posted at the website (10th paragraph; "invite only selected freelancers to bid on the project.")

Re Claim 4: Editors in view of McLoughlin discloses the claimed method but do not explicitly disclose wherein the reviewing the RFP by the financial institution further comprises the steps of:

- Retrieving the RFP from the website
- Studying the RFP; and
- Deciding whether to offer the financial product to the entity based upon the study

However these steps are old and well known and would have been obvious to anyone of ordinary skill as a way to review a potential business venture and then decide whether to enter into an agreement. Any company that receives an RFP would study the specifics related to the proposal and then determine whether it is in the business interest to follow through. This is standard business practice with regards to contract proposals.

Re Claim 5: Editors in view of McLoughlin discloses the claimed method but does not explicitly disclose the step of requesting additional information about the RFP. However this step is old and well known and would have been obvious to anyone of ordinary skill at the time of invention so that a potential vendor can receive more specific information that will assist the business in the decision to make an offer. In allowing for the further exchange of information between the entity and the financial institution, both parties can be sure that they are on the same page, and erroneous proposals are not issued as a result of a miscommunication in the original RFP.

Re Claim 6: Editors in view of McLoughlin discloses the claimed method but do not explicitly disclose wherein electronically notifying the entity of the result of the review by the financial institution further comprises the steps of:

- Assembling an offer for the financial product by the financial institution in a format that facilitates review by the entity; and
- Presenting the formatted offer to the entity

However these steps were old and well known in the art at the time of invention and would have been obvious to anyone of ordinary skill. Once the financial institution

Art Unit: 3692

had made the decision to make an offer to the entity, the next stage is to submit a proposal that would maximize the chance of landing the contract. In providing the entity with an appropriately formatted offer, the financial institution will place itself in a more favorable position, as the entity will not need to do any further processing in order to evaluate the proposal. Editors further discloses that the parties involved can manage the project using tools including messaging and file sharing, which indicates formatting compatibility. (10th paragraph).

Re Claim 7: Editors in view of McLoughlin discloses the claimed method and McLoughlin further discloses wherein the financial product being selected from the group consisting of investment products, trustee products, financing products, advisory products, depository products, employee retirement products, advisory products and audit products (see abstract; "limited-obligation bonds").

Re Claim 8: Editors discloses a method for an entity, the entity being a governmental or business entity, to procure a product from an institution comprising the steps of:

- Posting a request for a proposal (RFP) for the product of the entity to a website the RFP having been authorized by the entity (Page 2, 10th paragraph), wherein posting further comprises profiling the entity by obtaining information about the entity that may be utilized by the institution's decision to offer the product to the entity (page 2, 10th paragraph "search the freelancer profiles.")

- Electronically notifying the institution that the RFP has been posted (Page 2, 10th paragraph)
- Reviewing the RFP by the institution (Page 2, 10th paragraph the step of bidding implies that the RFP has been reviewed)
- Electronically notifying the entity of a result of the review by the institution (Page 2, 10th paragraph)

Editors does not explicitly disclose wherein the product is a financial product consisting of investment products, trustee products, financing products, advisory products, depository products, employee retirement products, advisory products and audit products, from and institution; and wherein the institution is a financial institution.

Editors further does not disclose wherein the posting further comprises the steps of, providing a deal sheet, deal sheet outlining the entity's need for the financial product and authorizing the posting of the RFP by an official of the entity.

McLoughlin discloses that governments have, for some time, issued a request for proposal as a means of selecting an underwriter to finance bonds intended for public improvements (abstract). It would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of McLoughlin to the disclosure of Editors, as a means for a government entity to solicit a specific type of product or service from a specific type of vendor. While Editors does not explicitly disclose the products and/or services from which each government entity might solicit a vendor, McLoughlin details that a request for a financial product from a financial institution, via a RFP, is old and well known. Utilizing the Editors method of online dissemination of the financial product

Art Unit: 3692

RFP would therefore reach a greater audience and potentially lead to a better contract for the government entity.

McLoughlin further discloses

- Profiling the entity by obtaining information about the entity that may be utilized by the financial institution in making the financial institution's decision to offer the financial product to the entity (See abstract; "The RFP should describe the purpose for which the bonds will be issued, the source or sources of revenues expected to be pledged to bond security, the anticipated size and term of the issue...").
- Providing a deal sheet, the deal sheet outlining the entity's need for the financial product (See abstract; "The RFP should describe the purpose for which the bonds will be issued").

While the references do not explicitly disclose the step of authorizing the posting of the RFP by an official of the entity, this step is old and well known in the art and would have been obvious to anyone of ordinary skill to prevent the fraudulent and or mistaken posting of potential contracts to the system. In requiring an authorization step by an official the systems integrity can be maintained all parties can be assured a level of security in the process.

The references also do not explicitly disclose wherein the reviewing the RFP by the financial institution further comprises the steps of:

- Retrieving the RFP from the website
- Studying the RFP; and

- Deciding whether to offer the financial product to the entity based upon the study

However these steps are old and well known and would have been obvious to anyone of ordinary skill as a way to review a potential business venture and then decide whether to enter into an agreement. Any company that receives an RFP would study the specifics related to the proposal and then determine whether it is in the business interest to follow through. This is standard business practice.

Finally the references do not explicitly disclose wherein electronically notifying the entity of the result of the review by the financial institution further comprises the steps of:

- Assembling an offer for the financial product by the financial institution in a format that facilitates review by the entity; and
- Presenting the formatted offer to the entity

However, again, these steps were old and well known in the art at the time of invention and would have been obvious to anyone of ordinary skill. Once the financial institution had made the decision to make an offer to the entity, the next stage is to submit a proposal that would maximize the chance of landing the contract. In providing the entity with an appropriately formatted offer, the financial institution will place itself in a more favorable position, as the entity will not need to do any further processing in order to evaluate the proposal. Editors further discloses that the parties involved can manage the project using tools including messaging and file sharing, which indicates formatting compatibility (10th paragraph).

Re Claim 9: Editors discloses a method for an entity to procure a product from an institution comprising the steps of:

- Posting an entity's request for proposal for the product of the entity to a website, the RFP having been authorized by the governmental entity (Page 2, 10th paragraph)
- Electronically notifying the institution that the RFP has been posted (Page 2, 10th paragraph)
- Reviewing the RFP by the institution (Page 2, 10th paragraph); the step of bidding implies that the RFP has been reviewed)
- Electronically notifying the entity of a result of the review by the institution (Page 2, 10th paragraph)

Editors does not explicitly disclose wherein the product is a financial product and the institution is a financial institution. McLoughlin discloses that governments have, for some time, issued a request for proposal as a means of selecting an underwriter to finance bonds intended for public improvements (abstract). It would have been obvious to anyone of ordinary skill at the time of invention to include the teachings of McLoughlin to the disclosure of Editors, as a means for a government entity to solicit a specific type of product or service from a specific type of vendor. While Editors does not explicitly disclose the products and/or services from which each government entity might solicit a vendor, McLoughlin details that a request for a financial product from a financial institution, via a RFP, is old and well known. Utilizing the Editors method of online

Art Unit: 3692

dissemination of the financial product RFP would therefore reach a greater audience and potentially lead to a better contract for the government entity.

Re Claims 10-16: For the sake of brevity, these claims essentially contain the same limitations as previously rejected claims 2-8 respectively and are therefore rejected using the same art and rationale. The only difference is that the "entity" is further defined as a "governmental entity." McLoughlin defines a governmental entity and therefore the rejections for claims 2-8 can similarly be applied to claims 10-16.

Response to Arguments

Applicant's arguments filed 11/08/2006 have been fully considered but they are not persuasive.

Applicant first contends that the references are not easily combinable because the combination would require substantial reconstruction of the references. The examiner disagrees. Both references deal with soliciting business opportunities using RFP's. In Editors, a website is established for one entity to solicit business from another entity via an RFP. McLoughlin discloses the old and well-known process of soliciting an underwriter of a financial product by a government entity. The examiner does not buy the argument that a "substantial reconstruction" of the Editors disclosure is necessary, as the website described by Editors is simply there to facilitate transactions between entities, regardless of the type of good or service solicited. If an RFP can be posted for job seekers, the examiner maintains that it would be obvious to post any type of RFP in order to further facilitate the transaction depending upon the need of the requesting entity. Why would it take a substantial reconstruction of a website to post a

Art Unit: 3692

different type of RFP? Especially considering these RFPs are constructed and evaluated by the entities themselves and only posted on the site. The site just acts as a medium.

Second the applicant argues that there is no suggestion to combine the references, as the prior art must suggest the desirability of the claimed invention, and that no explicit motivation is found. However, the applicants argument is only for an explicit showing, while the MPEP states that "The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). With this more complete definition for motivation, the examiner believes that his burden has previously been met. The references both teach the utilization of RFP's to match parties with mutual interests. Again the examiner maintains that If an RFP can be posted for job seekers, it would be obvious to post any type of RFP in order to further facilitate the transaction depending upon the need of the requesting entity.

It also appears as if the examiner has used improper hindsight reasoning to come to the conclusion of obviousness. In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Reference again is made to the fact that both prior art references utilize RFPs, and while only one posts these RFPs on a website, a person of ordinary skill would have found it obvious to post any type of RFP on a website to facilitate the transaction and make the entire process more efficient for both requesters and bidders.

Finally the applicant has cited case law from 1923 regarding the pioneering of an invention as being non-obvious. However seeing as how this was before the current law established under the Patent Act of 1952, as well as other cases such as *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 which established the contemporary definition and factual inquiries for obviousness, the examiner feels this argument is erroneous. In addition, the references show, before the date of invention of the current application, both financial RFPs and RFPs on websites, so the examiner cannot agree that the applicant is the pioneer of the discovery and disclosure of the source and remedy of the problem, as alleged.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER